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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,690	12/04/2001	Richard Wojdyla	5384/55373	9872

7590 10/02/2003

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EXAMINER

LE, UYEN CHAU N

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/007,690	WOJDYLA ET AL.	
	Examiner	Art Unit	
	Uyen-Chau N. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to because of the following informalities:

Re claim 8, line 2: Substitute "identify" with – identity --.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1 and 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al (US 5,768,132).

Re claims 1 and 3-4, Cordery et al discloses a method for providing trace-ability of mail pieces, comprising the steps of creating plurality of mail pieces 4002; generating/providing a first identification code [4008, 4020] (col. 9, lines 16+) on the mailing pieces 4002 (fig. 4; col. 8, line 42 through col. 9, line 33); creating a mailing statement 5002 for the plurality of mail pieces 4002 (fig. 5; col. 9, lines 52+); generating/providing a second identification code 5004 on the mailing statement 402 (see fig. 5; col. 9, lines 65+); submitting the plurality of mail pieces to a postal service facility (col. 5, lines 52+); wherein the first identification code 4020 is in the form of encrypted including digital token (col. 8, lines 45+).

Cordery et al fails to teach or fairly suggest that the first identification code and the second identification code corresponding to a source of the mail pieces.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the first identification code and the second identification code corresponding to a source of the mail pieces in order to provide Cordery et al with a capability of identifying the mailer readily. Furthermore, such modification would have been an obvious extension as taught by Cordery et al, and therefore an obvious expedient.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al in view of Pintsov (US 6,009,416). The teachings of Cordery et al have been discussed above.

Re claim 2, Cordery et al fails to teach or suggest the step of verification using a barcode scanner.

Pintsov discloses a mail verification system comprising the steps of scanning the first identification code on the mail pieces by a scanner 510, then verifying the information with the mailing statement via the network connection 518 (fig. 5; col. 11, lines 11+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a barcode reader into the verification system of Cordery et al in order to provide Cordery et al with a faster system and more accurate system wherein the operator does not have to compare word by word, number by number, etc. which would take a longer time and the event of misreading may occur. Furthermore, such modification would have been an obvious extension as taught by Cordery et al, and therefore an obvious expedient.

Cordery et al as modified by Pintsov fails to teach or fairly suggest the step of scanning the second identification from the mailing statement to verifying the first identification code with the second identification code.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a barcode reader into the verification system of Cordery et al/Pintsov in order to provide Cordery et al/Pintsov with a faster system and more accurate system wherein the operator does not have to compare word by word, number by number, etc. which would take a longer time and the event of misreading may occur. Furthermore, such modification would have been an obvious extension as taught by Cordery et al/Pintsov, and therefore an obvious expedient.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al in view of Leon (US 20030028497). The teachings of Cordery et al have been discussed above.

Re claim 5, Cordery et al fails to teach or suggest that the first identification code is watermark.

Leon teaches a barcode 418 is watermark (fig. 4; page 1, paragraph [0021]).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate an invisible barcode as taught by Benson into the teachings of Cordery et al in order to provide Cordery et al with a more secure system, preventing the code from being manipulated by a mailer or an unauthorized operator.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al in view of Parkos (US 5,912,682). The teachings of Cordery et al have been discussed above.

Re claim 5, Cordery et al fails to teach or suggest that the first identification code is embedded into paper fibers.

Parkos teaches postage indicia 10' is embedded into paper fibers (fig. 2; col. 2, lines 41-58).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the use of paper fibers as taught by Parkos into the teachings of Cordery et al in order to provide Cordery et al with a capability of protecting the code/indicia from being damaged while handling or transporting and sorting the mails, and thus providing a more accurate system.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al in view of Benson (US 5,929,415). The teachings of Cordery et al have been discussed above.

Re claim 7, Cordery et al fails to teach or suggest that the first identification code is invisible.

Benson teaches a barcode 31 is invisible (fig. 1; col. 3, lines 20+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate an invisible barcode as taught by Benson into the teachings of

Cordery et al in order to provide Cordery et al with a more secure system, preventing the code from being manipulated by a mailer or an unauthorized operator.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al in view of Petkovsek (US 5,918,802). The teachings of Cordery et al have been discussed above.

Re claim 8, Cordery et al fails to teach or suggest the step of capturing and recording the identity of an individual submitting the plurality of mail pieces.

Petkovsek teaches the signature, which serves as the identity of the sender or an individual submitting the plurality of mail pieces being captured and recorded (fig. 5; col. 6, lines 32-40).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the step of capturing and recording the signature/identity of the sender as taught by Petkovsek into the teachings of Cordery et al in order to provide Cordery et al with a more secure system wherein the identity of the sender can be identified/retrieved readily.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Benson et al (US 6,039,257); Trimble (US 4,997,337); O'Callaghan et al (US 6,311,892); Wells et al (US 6,510,992); Pastor et al (US 5,390,251); Agnew et al (US 5,291,002); Pintsov et al (US 5,826,247); Pollard (US 5,745,590) are cited as of interest and illustrate a similar structure to a method and system for mailing security and trace-ability.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on SUN, M, W, F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Uyen-Chau N. Le

September 22, 2003


KARL D. FRECH
PRIMARY EXAMINER